

REMARKS

Applicant hereby responds to the Office Action of April 27, 2006, in the above-referenced patent application. Claims 1-15, 28 and 29 are pending in the above-referenced patent application.

Claims 1, 9, 12, 28 and 29 were rejected under 35 U.S.C. 103(a) as being unpatentable over US Pub. No. 2002/0007493 by Butler et al. ("Butler"), in view of USPN 6,324,694 to Watts et al. ("Watts").

Claims 2-8 and 13-15 were rejected under 35 U.S.C. 103(a) as being unpatentable over Butler in view of the specification related to MPEG-2 Standard.

Claims 10 and 11 were rejected under 35 U.S.C. 103(a) as being unpatentable over Butler in view of specification.

Claim 4 has been amended to further clarify the claimed limitations. New matter has not been added.

Argument

All of the rejections are respectfully traversed for at least the following reasons.

Rejection of Claims 1, 9, 12, 28 and 29 under 35 U.S.C. 103(a)

Rejection of Claims 1, 9, 12, 28 and 29 under 35 U.S.C. 103(a) as being unpatentable over Butler in view Watts, is respectfully traversed because at least for the following reasons no prima facie case of obviousness has been established, that is, the references, alone or in combination, do not disclose all of the claimed limitations.

According to **Claim 1**, a digital video service network comprises: means for providing a combined digital signal, the combined digital signal having information reflective of a regular program signal and a Banner Information signal; a receiver for receiving the combined digital signal and a presentation unit for displaying the combined digital signal, the Banner Information being presented to the presentation unit with the regular program; a controller that controls the presentation unit to display the Banner Information with the regular program upon end user permission only.

The Banner Information herein is different from the hyperlink overlays in Butler. Specifically, according to Butler (Abstract), a receiver such as a computer is configured to receive the video stream and accompanying supplemental data files and to display the hyperlink overlays in conjunction with the video stream. The receiving equipment is configured to render

video only in display areas that are set to the color key value. Thus, the video stream is rendered "behind" the hyperlink overlays, and the backgrounds of the overlays appear transparent.

However, the Banner Information claimed herein is displayed to partially occupy the end user's video presentation device. Whereas in Butler, the video stream is rendered "behind" the hyperlink overlays, and the backgrounds of the overlays appears transparent.

The Banner Information herein is defined as including contents in the forms of texts, graphics, images, or, any other type of audio visual information which is intended for commercial advertisement and can be presented to the user with any other type of digital television presentation. A hyperlink simply links to other pages, requiring a user to click on the link to access the other pages for information. In Butler a hyperlink overlay on the video stream links to other pages which the user operates on to access information. The user must take several steps to get access to the advertisement intended by the sender to be seen by the user. This means the advertisement display is not complete and the user must click on a hyperlink to see that advertisement. As claimed herein, the Banner Information is presented to the user as the advertisement, without the need for the user to necessarily click on a hyperlink to actually see the advertisement. Butler's multi-step process means the advertisement information is not displayed by Butler, rather links to advertisement information. By contrast, according to the present invention the Banner Information provides the advertisement information.

Butler does not disclose a combined signal, including the regular program and the Banner information, as claimed. Rather, Butler is directed to a video broadcast system including a broadcast source that broadcasts a video stream and provides accompanying supplemental data files. Each supplemental data file is an HTML file having instructions for rendering a hyperlink overlay on the video stream (Abstract). In Butler the video stream is transmitted to the receiver first, and subsequently the HTML files are transmitted (Butler, Para. [0052]). By contrast, as claimed herein, the combined signal is transmitted over the channel. Butler's mention in Para. [0015] (relied on by the Examiner) of sending ancillary digital data along with content, does not teach: providing a combined digital signal, the combined digital signal having information reflective of a regular program signal and a Banner Information signal, as claimed. As discussed, the Banner Information herein is not the same as the overlay or ancillary information in Butler. Further, Butler does not disclose: a receiver for receiving the combined digital signal and a presentation unit for displaying the combined digital signal, the Banner Information being presented to the presentation unit with the regular program, as claimed. The receiver herein is a specialized receiver that is provided to the end user (e.g., specification page 17, lines 26-28), rather than a general purpose computer in Butler. Indeed Butler does not disclose: a channel communicating the combined digital signal from the means for providing a combined digital signal to a specialized receiver.

Further, Butler does not disclose a controller that controls the presentation unit to display the Banner Information with the regular program upon permission only, as claimed. The Banner

Information herein is displayed only upon user permission. In Butler, hyperlinks are sent to the user computer without user permission. In contrast to the claimed invention, there is no controller in Butler that allows a user to disable display of hyperlink overlay.

Further, the logic 141 in Watts is a synchronizer which operates by requiring identification and timing information to synchronize subsidiary data 117 to primary content data 107. Logic 141 is not a controller that controls the presentation unit to display the Banner Information with the regular program upon permission only, as required by Claim 1. Watts, col. 2, line 63 - col. 4, line 35; col. 5, lines 28-33; col. 8, lines 17-29; col. 9, lines 31-38 (relied on by the Examiner), does not even mention the concept or words relating to permission and user permission, as claimed, and does not disclose that logic 141 controls display of information based on user permission, as claimed.

It is well settled that in order for a modification or combination of the prior art to be valid, the prior art itself must suggest the modification or combination, "...invention cannot be found obvious unless there was some explicit teaching or suggestion in the art to motivate one of ordinary skill to combine elements so as to create the same invention." *Winner International Royalty Corp. v. Wang*, No. 96-2107, 48 USPQ.2d 1139, 1140 (D.C.D.C. 1998) (emphasis added). "The prior art must provide one of ordinary skill in the art the motivation to make the proposed molecular modifications needed to arrive at the claimed compound." *In re Jones*, 958 F.2d 347, 21 USPQ.2d 1941, 1944 (Fed. Cir. 1992) (emphasis added). No motivation or

suggestion is provided in the references to combine them as the Examiner does.

Even if Butler and Watts are in the same field (as the Examiner states), which Applicant traverses, that is not the standard under 35 U.S.C. 103(a) for combining the references. The motivation for the combination is not in the references, and Butler indeed goes against such combination.

It is respectfully submitted that despite the Examiner's interpretations, Butler teaches away from the claimed invention and the modification/combination suggested by the Examiner. Butler's primary goal is a solution to overcome non-standard systems. Butler (Para. [0007]) states that: "There has been no widespread acceptance of any interactive television system. One impediment to such widespread acceptance is that each system uses *different standards* and protocols for providing data that is ancillary to the primary video content. Unless a single system is instituted as a standard, broadcasters will have to provide ancillary data in numerous different formats. This is a *significant impediment*." (Emphasis added). Butler (Para. [0008]) then goes on to provide a solution to overcome such non-standard systems, stating: "The invention removes this impediment by *utilizing conventional formats* for providing ancillary data along with video broadcasts, *along with a scheme for overlaying digital data content on the primary video stream*." (Emphasis added). As such, Butler specifically criticizes systems such as Watts which provide a different standard and protocol (e.g., a protocol specific to Watts). One of ordinary skill in the art knowing of Butler, would not then look to Watts to modify Butler according to

Watts which requires non-standard transmission, delivery and reconstruction protocols including a controller 504 specific to Watts. Further, one of ordinary skill in the art would not look to Butler for a solution provided by the present invention which uses e.g. a specialized receiver.

Further, there is no mention or motivation in Butler to ask for user permission. By contrast, the present invention is based on a model wherein the user is desirous of receiving Banner Information by providing such permission through a user interface implemented in the receiver which is provided to the user by contract/subscription, not disclosed by prior art.

Modifying Butler to require user permission for showing the hyperlinks overlays goes against Butler's stated purpose of utilizing conventional formats for providing ancillary data along with video broadcasts, along with a scheme for overlaying digital data content on the primary video stream. Nor would displaying Banner Information based on user permission, as claimed, be inline with Butler since in Butler hyperlinks are sent to the user whether or not the user wants them. Butler's model is based on sending hyperlink overlays to the user, and there is no point in disabling such feature in Butler as it would go against Butler's stated objectives. The Examiner states that Butler is silent on overlay display based on user permission, and then concludes that such silence would not dissuade a modification to disable overlays temporarily. Applicant traverses the Examiner's interpretation and conclusions. Again, silence on a modification is not the standard under 35 U.S.C. 103(a) for combining the references, rather the motivation for the combination must be present in the references. Butler's directive indeed goes

against such combination and modification suggested by the Examiner. The Examiner has not addressed these issues at all and simply uses a “why not” approach for one of ordinary skill in the art combining these references, rather than the legal standard under 35 U.S.C. 103.

The Examiner attempts to modify Butler by Watts in order to teach Applicant’s claimed invention, however it is respectfully submitted that the Examiner’s reasoning is not based on disclosure or suggestion in the references. Adding logic circuit 141 of Watts to Butler would go against Butler’s stated objective of standardization for providing ancillary data along with video broadcasts (i.e., a scheme for overlaying digital data content on the primary video stream). For at least these reasons, rejection of Claim 1, and all claims dependent therefrom (claims 2-7, 28 and 29), should be withdrawn.

Claim 9 was rejected for substantially the same reasons as Claim 1, and as in the previous office action, and is therefore allowable for at least the reasons provided in relation to Claim 1. The cited paragraphs in the references, alone or in combination, do not disclose the claimed limitations as the Examiner interprets them. Further, as claimed herein, the combined signal (including the regular program and the Banner Information) is transmitted over the channel. By contrast, in Butler the video stream is transmitted to the receiver first, and subsequently the HTML files are transmitted (Para. [0052]). Butler teaches against providing non-standard receivers to users for receiving and reconstructing regular programming and Banner Information on a display. Butler is against user permission for hyperlink overlays. Further, as discussed,

circuit 141 of Watts is not useable within the model of Butler, and there is no sufficient legal basis to combine Watts and Butler. For at least these reasons rejection of Claim 9, and all claims dependent therefrom (claims 10-15), should be withdrawn.

Regarding **Claim 12**, it is respectfully submitted that the references, alone or in combination, do not disclose the claimed limitations. For example, Butler does not disclose: “providing a receiver to end user,” as claimed. As discussed, the provided receiver is a specialized receiver.

Further, Butler does not disclose: “providing a receiver to end user’s which receiver: specifically enables the simultaneous display of the Banner Information and the regular programming on the presentation unit,” as required by Claim 12.

Further, for at least the reasons provided above in relation to Claim 1, Butler and Watts, alone or in combination, do not disclose providing a receiver to the user that: “allows controlling the presentation unit to display the Banner Information with the regular program only upon permission,” as required by Claim 12.

Butler is directed to generic personal computers for displaying video with hyperlink overlays in a computing environment where the user clicks on the hyperlinks for access to information. By contrast, according to the present invention, a receiver has specialized

components therein for receiving a combined signal of a regular program and Banner Information, to display both simultaneously according to end user permission. Further, as discussed, circuit 141 of Watts is not useable within the model of Butler, and there is no sufficient legal basis to combine Watts and Butler. For at least these reasons, rejection of Claim 12 should be withdrawn.

Rejection of **Claims 28 and 29** is respectfully traversed for at least the reasons provided above.

Rejection of Claims 2-8 and 13-15 under 35 U.S.C. 103(a)

Rejection of Claims 2-8 and 13-15 under 35 U.S.C. 103(a) as being unpatentable over Butler in view of the specification is respectfully traversed because at least for the following reasons no prima facie case of obviousness has been established.

Despite the Examiner's interpretations, each reference is considered individually with respect to limitations which the Examiner has concluded that reference discloses. If the Examiner includes that a reference A discloses a limitation 1, and a reference B discloses a limitation 2, then Applicant can attack Examiner's conclusion that reference A discloses limitation 1, and further Applicant can attack Examiner's conclusion that reference B disclosed limitation 2.

Regarding **Claim 2**, as discussed, Butler does not disclose all of the limitations of base Claim 1. Further, as the Examiner also states, Butler does not disclose a TS Packetized combined signal. In addition, the information in the specification (relied on by the Examiner) is a general reference to MPEG-2 standard. As such, teaching of TS packetized combined digital signal for a regular program and Banner Information, as claimed, is disclosed by the present invention. There is no suggestion or motivation in Butler to utilize TS packetized combined digital signal for a regular program and Banner Information, as claimed herein. The present invention mentions aspects of the MPEG-2 standard, and then provides teachings according to the present invention that are not disclosed by the references alone or in combination, to provide the claimed digital video service network (e.g., Claims 1-7). Modifying teachings of Butler with MPEG-2 standard to combine a regular program and Banner Information as TS packetized combined digital, as claimed, would require a substantial undertaking, not disclosed by the references.

Again, the Examiner has not addressed these issues at all and simply uses a “why not approach”, and hindsight, for one of ordinary skill in the art combining these references. The test of obviousness is not shifting the burden of proof to Applicant to show why one of ordinary skill in the art would combine the references, rather the Examiner must establish that the references disclose the claimed limitations, and that there is motivation and suggestion in the references to combine them. The Examiner has again failed to establish such motivation.

The general reference to MPEG-2 in Butler in conjunction with MPEG-2 standard definition is not a disclosure of the claimed limitations. Just because Butler mentions MPEG-2 it does not mean that Butler teaches how to use MPEG-2 to achieve the claimed limitations. Indeed, there is no teaching or suggestion in Butler that a TS packetized signal can even be used. There is no such disclosure in Butler. Applicant has set forth concise arguments showing why Butler does not disclose the claimed limitations, and how just the knowledge of MPEG-2 in conjunction with Butler is insufficient to motivate a combination to render the claims obvious. The Examiner seems to state that because MPEG-2 is generally known, then any invention that uses MPEG-2 would simply plug-it in and so render that invention obvious. Though MPEG-2 maybe within the general knowledge of one of ordinary skill in the art, Applicant respectfully submits that that does not mean that simply because Butler mentions MPEG-2, one of ordinary skill in the art would have then been clued into using a TS packetized signal in Butler. The entire gist of the Examiner's arguments and conclusions are without support in the references and outside the scope allowed under 35 U.S.C. 103(a). For at least these reasons, rejection of Claim 2 should be withdrawn.

Regarding **Claim 3**, as discussed, Butler does not disclose limitations of base Claim 1. Further, Butler does not disclose a first coding unit for coding the regular program signal and a second coding unit for coding the Banner Information signal, a first TS packetization unit for receiving the coded regular program signal and providing a packetized bit stream reflecting the coded regular program signal and a second TS packetization unit for receiving the coded Banner

Information signal and providing a packetized bit stream reflecting the coded Banner Information signal, a TS Packet multiplexer for receiving the packetized regular program signal and the packetized Banner Information signal and providing a multiplexed transport stream, and a channel modulation unit for modulating the transport stream into the combined digital signal and sending the combined digital signal for transmission to the channel, as required by Claim 3.

The Examiner is impermissibly minimizing the teaching of the present invention as known MPEG-2 standard. This is traversed. The present invention mentions aspects of the MPEG-2 standard, and then provides teachings according to the present invention that are not disclosed by the references alone or in combination, to provide the claimed features. There is no teaching in Butler of such teachings for TS packetized combined digital signal of a regular program and Banner Information as claimed herein. Nor is there any motivation for modifying Butler as suggested by the Examiner. At its base, the Examiner is using Applicant's own teachings (not disclosed by the references alone or in combination) to modify Butler in order to reject the claimed limitations. This is impermissible under 35 U.S.C. 103(a), and is respectfully traversed.

Not only does Butler and MPEG-2 standard not disclose the claimed limitations, but also the references do not motivate modifying teachings of Butler per MPEG-2 standard to combine a regular program and Banner Information as TS packetized combined digital as claimed. Such modification would require a substantial undertaking and numerous elements which are not

obvious. The general reference to MPEG-2 in Butler in conjunction with MPEG-2 standard definition is not a disclosure of the claimed limitations. Indeed, there is no teaching or suggestion in Butler that a TS packetized signal as in Claim 3 can even be used. The Examiner is improperly using “hindsight” and the teachings of Applicant’s own claimed invention in order to combine references to render Applicant’s claims obvious. The Examiner admits that Butler fails to teach all of the limitations of Applicant’s claimed invention. However, the Examiner improperly attempts to modify Butler in an attempt to achieve Applicant’s claimed invention.

Similarly, there is no such disclosure in Butler of a channel modulation unit for modulating the transport stream into the combined digital signal and sending the combined digital signal for transmission to the channel (Claim 3). A “modulation” function of any sort is not even discussed or mentioned in Butler. It is respectfully submitted that the Examiner is improperly reading limitations into Butler that are not there. There is no modulation disclosure in para. [0013] or [0032] of Butler, as claimed herein. The Examiner has not shown that any modulation used in Butler, if any, has anything to do with the claimed limitations. The unpublished application Serial No. 08/503,055 (Newell), relied on by the Examiner is not qualifying prior art. Applicant reserves the right to provide further arguments/evidence in this regard. Nor does Newell disclose any of the claimed limitations, such as the claimed modulation, as suggested by the Examiner. Further, Newell is non-analogous art related to broadcasting from personal computers. The Examiner has not taken the proper steps in showing that Newell is qualifying proper prior art. Therefore, the Examiner cannot use Newell in rejecting the claims.

For at least these reasons, rejection of Claim 3 should be withdrawn.

Claim 15 was rejected for similar reasons as rejection of Claim 3. As such, it is respectfully submitted that rejection of Claim 15 should be withdrawn for at least the reasons provided above in relation to Claims 3 and 9.

Claims 4-7, 13 and 14 were rejected essentially based on elements 60, 66 and 68 of Butler. Rejection of these claims is respectfully traversed because as discussed Butler does not disclose limitations of base Claims 1, 9 and 16. The Examiner refers to video subsystem 66 of Butler, but without specific reference to relevant description in Butler, and has summarily interpreted element 66 to disclose several of the claimed limitations herein (i.e., a Banner Information TS depacketizer, a Rendering Unit, a video reconstruction unit, Audio/video decoders, etc.). This is without pointing to disclosure in Butler that states that the element 66 discloses such claimed limitations. The Examiner has generally referred to paragraphs [0032] - [0039] of Butler, without any clear statement as to where in such paragraphs each specific limitation is disclosed. It is respectfully submitted that no such limitations are disclosed in Butler regarding element 66 or any other element. Further, the Examiner refers to tuner 60 of Butler, but without specific reference to relevant description in Butler, and has summarily interpreted tuner 60 to disclose several of the claimed limitations herein (i.e., a channel demodulation unit, a TS demultiplexer unit, etc.). However, the rejection must be based on disclosure in the reference, and not the Examiner's general interpretation of the reference as convenient for

rejecting the claims. The Examiner has generally referred to paragraphs [0032] - [0039] of Butler, without any clear statement where in such paragraphs each specific limitation is disclosed. It is respectfully submitted that no such limitations are disclosed in Butler regarding element 60 or any other element

In addition, regarding Butler and the above MPEG-2 standard, there is no suggestion or motivation in Butler to utilize such teachings for TS packetized combined digital signal of a regular program and Banner Information as claimed herein. What the Examiner considers details associated with the implementation without specific reference to Butler as discussed, are not trivial or obvious. The effort required to modify teachings of Butler and MPEG-2 standard to combine a regular program and Banner Information as TS packetized combined digital as claimed would require a substantial undertaking and numerous elements which would not be obvious. The general reference to MPEG-2 in Butler in conjunction with MPEG-2 standard definition is not a disclosure of the claimed limitations. Indeed, there is no teaching or suggestion in Butler that a TZ packetized signal as claimed can even be used. The Examiner improperly attempts to modify Butler in an attempt to achieve Applicant's claimed invention. For at least these reasons, rejection of claims 4-7, 13 and 14 should be withdrawn.

Claim 8 was rejected for essentially the same reasons as rejection of Claims 1, 3 and 4, and as such Claim 8 is allowable for at least the reasons provided above in relation to Claims 1, 3 and 4.

Rejection of Claims 10 and 11 under 35 U.S.C. 103(a)

Rejection of Claims 10 and 11 under 35 U.S.C. 103(a) as being unpatentable over Butler in view of the specification is respectfully traversed because at least for the following reasons no prima facie case of obviousness has been established.

As per rejection of **Claims 10 and 11**, as discussed, Butler does not disclose all of the limitations of base Claim 9. Applicant maintains that the prior art does not disclose the claimed limitations, and any examples used by the Examiner as prior art must be established by the Examiner as prior art under 35 U.S.C. 102 and 103 (which the Examiner failed to do in this Office Action and in the previous Office Action). The Examiner did not establish in any of the Office Actions proper prior art which disclosed entering into an agreement with end users which allows for the simultaneous display of the Banner Information and the regular programming on the presentation unit (Claim 10). Nor did the Examiner establish in any of the Office Action proper prior art which discloses than an agreement provides for a limitation on the subscription charged to the end users (Claim 11).

The Examiner admits that Butler fails to teach all of the limitations of Applicant's claimed invention. However, the Examiner improperly attempts to modify Butler in an attempt to achieve Applicant's claimed invention. There is no suggestion or motivation to modify Butler for entering into an agreement with end users which allows for the simultaneous display of the

Banner Information and the regular programming on the presentation unit (Claim 10). Nor is there any suggestion or motivation to modify Butler wherein the agreement provides for a limitation on the subscription charged to the end users (Claim 11). There is no user control in Butler over the hyperlink overlays as claimed.

There is no reason for Butler's users to enter into an agreement for hyperlink overlays since the hyperlink overlays do not interrupt the video stream of Butler as commercials do. By contrast, since a typical commercial does interrupt video programming, according to the claimed invention, user agreements are utilized to provide uninterrupted programs wherein user has control over how those commercials are viewed (e.g., Banner Information). This is not even necessary in Butler since the hyperlinks are simply an added feature, not a solution to otherwise interrupted regular programming. Butler's model is different from that of the claimed invention. For at least these reasons, rejection of Claims 10 and 11 should be withdrawn.

Further, Examiner's interpretation of Applicant's response as admission of fact is erroneous and traversed for at least the reasons stated herein, the reasons provided in prior responses, and other reasons. In addition, with respect to claim rejections where Examiner improperly relies on improper conclusions of admission of Applicant and/or specification of the invention, Applicant respectfully submits that instead of providing qualified prior art which discloses the claimed limitations, the Examiner interprets the specification of the present invention, and Applicant's arguments, as admitting prior art to the present invention which the

Examiner uses to reject the claims. The specification of the present invention does not in any way admit that the claimed limitations are prior art as the Examiner misinterprets the specification. Further, the Examiner keeps referring to admitted prior art, which Applicant continues to traverse as any admission, or admission of prior art or admission of fact. It is respectfully submitted that the entire structure of Examiner's arguments based on Examiner's conclusions of admitted prior art, and/or admissions of facts by Applicant, and the like, are without basis and are continually traversed. Further, Applicant respectfully traverses the Examiner's conclusion that Applicant did not adequately counter Examiner's Official Notice as to the existence of service agreements that allow viewers to watch distributed programming and provide a limitation on the subscription charged to the end user. Applicant disagrees with the Examiner's interpretation of Applicant's clear traversal of that Official Notice in Applicant's response to the first office action as inadequate and admission of fact. Indeed, Applicant has adequately traversed, and again now traverses, such Official Notice by the Examiner, since, as Applicant has argued that such limitations are teachings of the present invention and not disclosed by prior art. Further, the Examiner has not provided proper references in support of such conclusions in the Official Notice. If the claimed limitations are so well known, why has not the Examiner provided a single qualifying reference as prior art to the present invention which clearly discloses the claimed limitations rather than relying on Official Notice without more. All of the Examiner's arguments and conclusions about Applicant's admission of fact, admission of prior art, etc. are respectfully traversed as without basis or justification, and are rather self-serving for improperly rejecting the claims. Instead of providing qualifying prior art,

it is respectfully submitted that the Examiner improperly interprets Applicant's arguments as admissions and proceeds to reject the claims based on Examiner's own improper conclusions rather than qualified prior art under the law which discloses the claimed limitations. Applicant reserves the right to provide further arguments/evidence in support of its position.

CONCLUSION

If necessary, the Commissioner is hereby authorized to charge payment or credit any overpayment to Deposit Account No. 01-1960 for any additional fees required in connection with this filing. A duplicate copy of this page is enclosed for this purpose.

For these, and other, reasons, Applicants believe that the claims are in condition for allowance. Reconsideration, re-examination, and allowance of all claims are respectfully requested.

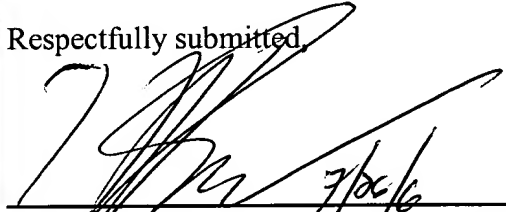
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: MS Amendment Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on July 26, 2006.

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